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EXAMINER	
LUONG, VINH	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/681,441	Applicant(s) FALL, PETER	
	Examiner Vinh T Luong	Art Unit 3682	MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5,6 and 8-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5,6 and 8-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Vinh T. Luong
Primary Examiner

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 December 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *Exhibits I & II.*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 19, 2003 has been entered.

2. The restriction requirement on August 21, 2002 in the parent application has been withdrawn in view of applicant's explicit admission that the two embodiments illustrated in the figures are not patentably distinct in the Reply under 37 CFR 1.111 filed on October 15, 2002 (Paper No. 10).

3. The listing of references in the specification (page 1) is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

4. The amended drawings were received on December 19, 2003. These drawings are disapproved because new Fig. 3 introduces new matter, such as, (a) the number, size, shape, dimension of the telescopic elements 16 and 16 (see Exhibit I); and (b) the locations of the pivot joints as now shown in Fig. 3.

Although the original specification describes "a rigid telescoping element that is pivotally joined to the respective arms at both ends," however, the original disclosure does not describe, among other things, the following:

(1) How many elements of which the telescoping element is comprises;

(2) How the telescopic elements are connected to each other;

(3) The size(s), shape(s), and dimension(s) of the telescopic elements 16 and 16' relative to each other; and

(4) The specific locations of the pivot joints of the telescopic elements 16 and 16' to the pedal arm and the lever.

In other words, the original disclosure implies, e.g., that: (1) the rigid telescoping element may comprise more than two elements 16 and 16' (see Exhibit I) as now shown in new Fig. 3; (2) the shape(s) of a cross section of the telescopic elements 16 and 16' (Exh. I) may be circular, square, or rectangular, etc.; and (3) the telescopic elements 16 and 16' may be pivoted at the side of the lever 11 as now shown in new Fig. 3 or at the front surface of the lever 11 as shown in Figs. 1 and 2. The specific showing of: (a) the number, size, shape, dimension of the telescopic elements; and (b) the locations of the pivot joints within a full spectrum of possible numbers, sizes, shapes, dimensions of the telescopic elements and locations of the pivot joints is considered under the present disclosure to be new matter. *Cf., In re Smith*, 173 USPQ 679 (CCPA 1972) and *Ex parte George*, 230 USPQ 575, 578 (BPAI 1986).

Another example, the concept that the telescoping element is pivoted centrally at the side of the lever 11 as now shown in new Fig. 3 is not conveyed in the original disclosure, *i.e.*, new matter. *In re Anderson*, 176 USPQ 331 (CCPA 1973).

5. The *original* drawings are objected to because each part of the invention, such as, the cab in claims 1, 8, and 18, and the telescoping member in claims 11-13 should be designated by a referential numeral or character. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The *original* drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features such as the

cab in claims 1, 8, and 18; and the telescoping member in claims 11-13 must be shown or the features canceled from the claims. No new matter should be entered.

Applicant's drawings do not show the cab. See, e.g., the cab 1 in Fig. 1 of US Patent No. 6,082,219 issued to Wolpert.

7. The amendment filed December 19, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amendment in the last paragraph of the specification. The original disclosure does not provide support, *inter alia*, for the number of telescopic elements 16 and 16' (Exh. I), size, shape, and dimension of the telescopic elements; and the specific locations of the pivot joint which is at the center of the side of the lever 11 as now shown in new Fig. 3. See explanation of the disapproval of new Fig. 3 above. Applicant is required to cancel the new matter in the reply to this Office Action.

8. Claims 8-17 are objected to because of the following informalities: no antecedent basis is seen for the term, such as, "the cab" in line 5 of claim 8. Appropriate correction is required.

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 11-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 11-13 call for a telescoping member. However, the original drawings do not show the telescoping member. It was unclear as to how applicant makes/uses the claimed telescoping member and connected it to claimed pedal arrangement at the time the application

was filed. See *Regents of the University of California v. Eli Lilly*, 43 USPQ2d 1398, 1404 (CAFC 1997); *Vas-Cath, Inc. v. Mahurkar*, 19 USPQ2d 1111, 1116 (CAFC 1991) and MPEP 2163.

11. Claims 1-3, 5, 8-12, 14, 16, and 17 are rejected under 35 U.S.C. 102(b) as anticipated by Bayer (German OS No. 31 40329 A1 cited by applicant).

Regarding claim 1, Bayer teaches a pedal arrangement in a vehicle cab, said arrangement comprising:

a support 26 fixed in the cab (Fig. 2);

at least one pedal arm 22 having two ends (at 18 and 22 in Fig. 1), wherein the pedal arm 22 is journaled in the support 26 for pivoting about a pivot axis 24 spaced between the two ends of the pedal arm 22;

a foot plate (unnumbered, see Exhibit II) fixed to a first portion (at 22 in Fig. 1) of the pedal arm 22 on one side of the pivot axis;

a motion-transmitting element 10 inherently disposed wholly within the cab, wherein the motion-transmitting element 10 is joined firstly to a second portion 18 of the pedal arm 22 on the other side of the pivot axis 24 from the foot plate and wherein the motion-transmitting element 10 is joined secondly to a pivotally mounted lever 4 that is configured so that pivotation thereof actuates an operating device 2; and

wherein the motion-transmitting element 10 is disposed so that the distance between the motion-transmitting element's respective attachment points (Exh. II) to the pedal arm 22 and the lever 4 is maintained at least substantially constant when there is a tensile force on the element 10 (i.e., when the foot plate is moved downwardly as shown by solid line position in Fig. 1) and is allowed to be mom-fixedly shortened when there is compressive force on the

element 10 (i.e., when the foot plate is moved upwardly as shown in dashed line position in Fig. 1); and

wherein the motion-transmitting element 10 is rigidly fixed to at least one of the pedal arm 22 and the lever 4, and is pivotally joined to the other of the pedal arm 22 and the lever 4.

Claim 1 and other claims below are anticipated by Bayer under the principle of inherency. Since applicant's drawings do not show the cab, therefore, if one interprets the cab as the vehicle 1 shown in Fig. 1 of US Patent No. 6,082,219, Bayer's element 10 is extended from an end of the pedal 22 of the cab to an end of the braking device 4, 2 of the cab. Thus, Bayer's pedal 22 and braking device 4, 2 are inherently disposed wholly within the cab as visualized by Fig. 1 of Pat.'219. Consequently, Bayer's element 10 is also disposed wholly within the cab. On the other hand, Bayer teaches each claimed element and its functional statement. It is well settled that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In addition, it is well established that: (a) a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art teaches all the structural limitations of the claims. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987); and (b) the functional limitations of a claim may not be given patentable weight where those limitations are inherent in a prior art reference. *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997).

Regarding claim 2, the motion-transmitting element is an elongated flexible element 10.

Regarding claim 3, the motion-transmitting element is a metal cable 10.

Regarding claim 5, the motion-transmitting element 10 is rigidly fixed both to the pedal arm 22 and to the lever 4.

Regarding claim 8, Bayer teaches a brake pedal arrangement in a vehicle, said arrangement comprising:

a brake pedal arm 22 pivotally connected to the vehicle at a pivot point 24 located on the brake pedal arm 22, the pivot point 24 being positioned between an upper end 18 and a lower end (at 22 in Fig. 1) of the brake pedal arm 22; and

a motion-transmitting element 10 inherently disposed wholly within the cab and being connected between the brake pedal arm 22 and a pedal actuated operating device 4, 2, the motion-transmitting element 10 supporting tensile forces imposed thereupon (i.e., when the foot plate is moved downwardly as shown by solid line position in Fig. 1), and non-fixedly collapsing under compressive forces imposed thereupon (i.e., when the foot plate is moved upwardly as shown in dashed line position in Fig. 1).

Regarding claim 9, the motion-transmitting element comprises a cable 10.

Regarding claim 10, the motion-transmitting element comprises a bendable member 10.

Regarding claim 11, the motion-transmitting element 10 comprises a telescoping member since the element 10 is slid back and forth (telescope) within another element, i.e., a conduit 12.

Regarding claim 12, the telescoping member 10 is pivotally connected to the brake pedal arm 22.

Regarding claim 14, the motion-transmitting element 10 is fixed at least at one end thereof between the brake pedal arm 22 and the pedal actuated operating device 2, 4.

Regarding claim 16, the motion-transmitting element 10 is pivotally connected at least at one end thereof between the brake pedal arm 22 and the pedal actuated operating device 2, 4.

Regarding claim 17, the pedal actuated operating device comprises a pressure actuated servo unit 2 for affecting brake pressure application.

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1, 2, 5, 6, 8, 10, 14, and 16-20, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Wolpert (US Patent No. 6,082,219 filed on February 20, 1998).

Regarding claim 1, Wolpert teaches a pedal arrangement in a vehicle cab 1, said arrangement comprising:

a support 11 fixed in the cab 1 (Fig. 2);

at least one pedal arm 8, 20 having two ends 8 and 10, wherein the pedal arm 8, 20 is journaled in the support 11 for pivoting about a pivot axis 13 spaced between the two ends 8 and 20 of the pedal arm 8, 20;

a foot plate (unnumbered) fixed to a first portion 8 of the pedal arm 8, 20 on one side of the pivot axis 13;

a motion-transmitting element 14 disposed wholly within the cab 1 (Fig. 1), wherein the motion-transmitting element 14 is joined firstly to a second portion 20 of the pedal arm 8, 20 on the other side of the pivot axis 13 from the foot plate and wherein the

motion-transmitting element 14 is joined secondly to a pivotally mounted lever 15 that is configured so that pivotation thereof actuates an operating device 10; and

wherein the motion-transmitting element 14 is disposed so that the distance between the motion-transmitting element's respective attachment points (Fig. 2) to the pedal arm 8 and the lever 15 is maintained at least substantially constant when there is a tensile force on the element 14 (i.e., when the foot plate is moved downwardly as shown by dashed line position in Fig. 2) and is allowed to be shortened when there is compressive force on the element 14 (i.e., when the foot plate is moved upwardly as shown in solid line position in Fig. 2); and

wherein the motion-transmitting element 14 is rigidly fixed to at least one of the pedal arm 20, 8 and the lever 15, and is pivotally joined to the other of the pedal arm 8 and the lever 15.

Claim 1 and other claims below are anticipated by Wolpert. On the one hand, Wolpert teaches each claimed element and its functional statement. On the other hand, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. *In re Casey* and *In re Otto, supra.* On the other hand, it is well established that: (a) a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art teaches all the structural limitations of the claims. *Ex parte Masham, supra.*

Regarding claim 2, the motion-transmitting element is an elongated flexible element 14. The element 14 of Wolpert is inherently *flexible* since virtually anything will be flexed if enough

pressure is applied to it. See the term "flexibility" in *Fredman v. Harris-Hub Co., Inc.*, 163 USPQ 397 (DC 1969).

Regarding claim 5, the motion-transmitting element 14 is rigidly fixed both to the pedal arm 20, 8 and to the lever 15.

Regarding claim 6, the lever 15 is joined to a rocker arm 16, which, when the lever 15 is pivoted, acts on an actuator rod 17 for a brake servo unit 10, which is located on the outside of an intermediate wall 4 on the inside of which the support 11 is located spaced from the intermediate wall 4 (Figs. 1 and 2).

Regarding claim 8, Wolpert teaches a brake pedal arrangement in a vehicle 1, said arrangement comprising:

a brake pedal arm 20, 8 pivotally connected to the vehicle 1 at a pivot point 13 located on the brake pedal arm 20, 8, the pivot point 13 being positioned between an upper end 20 and a lower end 8 of the brake pedal arm 20, 8; and

a motion-transmitting element 14 disposed wholly within the cab 1 and being connected between the brake pedal arm 20, 8 and a pedal actuated operating device 10, 12, etc., the motion-transmitting element 14 supporting tensile forces imposed thereupon (i.e., when the foot plate is moved downwardly as shown by dashed line position in Fig. 2), and non-fixedly collapsing under compressive forces imposed thereupon (i.e., when the foot plate is moved upwardly as shown in solid line position in Fig. 2).

Regarding claim 10, the motion-transmitting element comprises a bendable member 14. The element 14 of Wolpert is inherently *bendable* since virtually anything will be bent if enough pressure is applied to it. See the term "flexibility" in *Fredman v. Harris-Hub Co., Inc., supra.*

Regarding claim 14, the motion-transmitting element 14 is fixed at least at one end thereof between the brake pedal arm 20, 8 and the pedal actuated operating device 10, 12, etc.

Regarding claim 16, the motion-transmitting element 14 is pivotally connected at least at one end thereof between the brake pedal arm 20, 8 and the pedal actuated operating device 10, 12, etc.

Regarding claim 17, the pedal actuated operating device comprises a pressure actuated servo unit 10 for affecting brake pressure application.

Regarding claim 18, Wolpert teaches a pedal arrangement for a vehicle cab 1, said arrangement comprising:

a pivot axis 13 connected to a support 11 fixed to the vehicle cab 1;

a pedal arm 8, 20 arranged to be pivotally connected to the pivot axis 13 at a pivot point 13 located on the pedal arm 8, 20, the pivot point 13 being positioned between an upper end and a lower end of the pedal arm 8, 20;

a pedal actuated operating device 10, 12, etc. including a bracket 12 fixed to the vehicle cab 2, 5, a rocker arm 16 journaled in the bracket 12 (at 19 in Fig. 2) and a lever arm 15 connected to the rocker arm 16; and

a motion-transmitting element 14 disposed wholly within the cab 1 and being connectable between the pedal arm 8, 20 and the lever arm 15 of the pedal actuated operating device 10, 12, etc., wherein the motion-transmitting element 14 supports tensile forces imposed upon the motion-transmitting element 14, and wherein the motion-transmitting element 14 non-fixedly collapses under compressive forces imposed upon the motion transmitting element 14.

Regarding claim 19, the motion transmitting element 14 is a bendable member 14.

Regarding claim 20, the motion transmitting element 14 is rigidly fixed to at least one of the pedal arm 8, 20 and the lever arm 15, and is pivotally joined to the other of the pedal arm 8, 20 and the lever arm 15.

14. Claims 13 and 15, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayer.

Bayer teaches applicant's embodiment in Fig. 1. Applicant explicitly admits that applicant's embodiment of Fig. 1 and applicant's embodiment of Fig. 2 are not patentably distinct in Paper No. 10. In addition, claims 13 and 15 are drawn to applicant's embodiment of Fig. 1.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to weld at least one end of the telescoping member (motion transmitting element) of Bayer to the brake pedal arm as explicitly admitted by the applicant that applicant's welding embodiment of Fig. 1 is an obvious variant of applicant's embodiment of Fig. 2. See fifth paragraph on page 2 of the restriction on August 21, 2002, *In re Lee*, 199 USPQ 108 (Comm'r Pat. 1978), MPEP 803, and *Anything You Say Can Be Used Against You*, Lance Leonard Barry, May 2000, JPTOS, Volume 82, No. 5, page 347.

15. Claim 15, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolpert.

Wolpert teaches applicant's embodiment in Fig. 1. Applicant explicitly admits that applicant's embodiment of Fig. 1 and applicant's embodiment of Fig. 2 are not patentably distinct in Paper No. 10. In addition, claims 13 and 15 are drawn to applicant's embodiment of Fig. 1.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to weld at least one end of the motion transmitting element 14 of Wolpert to the brake pedal arm as explicitly admitted by the applicant that applicant's welding embodiment of Fig. 1 is an obvious variant of applicant's embodiment of Fig. 2. See fifth paragraph on page

2 of the restriction on August 21, 2002, *In re Lee*, MPEP 803, and *Anything You Say Can Be Used Against You, supra.*

16. Applicant's arguments filed December 19, 2003 have been fully considered but they are not persuasive.

DRAWINGS & SPECIFICATION

Applicant contends that:

> *Submitted herewith is a Figure 3 for entry in this application. The specification already provided sufficient basis for this drawing. In particular, the specification already taught that the flexible element already depicted in the figures could be a "rigid telescoping element" instead of a steel cable or other flexible element. The specification also specifically taught that this telescoping element could be "pivotally joined to the respective arms at both ends." The originally submitted specification, as per the originally presented claims, also taught that, at least one of the ends of the rigid telescoping - element could be welded to one of the respective arms.* ***Newly submitted Figure 3 comports exactly with these descriptions and further does not otherwise deviate from the teachings of the drawings as already submitted.*** *The applicant therefore respectfully submits that no new matter has been presented. The applicant also takes this opportunity to note that the specification is being amended as per this response to include references to the appropriate corresponding reference numerals as regards the rigid telescoping element and to also provide specific antecedent basis in the specification for the previously submitted claim language regarding welding of the rigid telescoping element instead of pivotally joining as an affixment technique. Again, full support exists in the complete specification, including the claims, as originally filed and hence no new matter has been entered.*

The examiner respectfully submits that a verbal description can be shown in a variety different ways. For example, the recitation "a nut and a bolt" can be shown by thousands of different patents in Class 411 (expanded, threaded, driven, headed, tool-deformed, or locked-threaded fastener) of the Office. In the instant case, the description "a rigid telescoping element that is pivotally joined to the respective arms at both ends" on page 4 of the original specification

plainly may be illustrated in different ways. Newly submitted Figure 3 does not comport exactly with the descriptions and further does deviate from the teachings of the drawings as already submitted as evidenced by, e.g., the location of the new pivot joint of the telescoping element 16 with the lever 11. The examiner is mindful that if the best mode contemplated by the inventor at the time of filing the application is not disclosed, such defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the application was originally filed. *In re Hay*, 189 USPQ 790 (CCPA 1976) cite in MPEP 608.01(h). The examiner respectfully disapproves new Fig. 3 and objects to the amendment to the specification for the reasons set forth in paragraphs 3 and 7 above.

35 USC 112, SECOND PARAGRAPH

The rejection under 35 USC 112, second paragraph, is withdrawn in view of applicant's amendment.

First Rejection under 35 USC 102

Bayer

Applicant asserted that:

> *Although Bayer appears to suggest use of a wire (10) to connect a brake pedal arm to an actuator lever, Bayer appears to provide this teaching in a specific context. That is, there is a considerable distance between the brake pedal arm and the actuator arm. In fact, while the brake pedal arm resides within the vehicle cab, the actuator arm and the majority of the wire are external to the vehicle cab. Such an arrangement does not pose the same risks and issues that the applicant seeks to address. Similarly, Bayer teaches one skilled in the art only that a wire can be utilized to couple a brake pedal arm and actuator arm that reside on different sides of a vehicle cab wall and that are separated by a considerable distance.*
>
> *Conversely, the applicants address a concern that arises when these various mechanisms are in relatively close proximity to one another and are both found within the vehicle cab. Bayer's teachings are not applicable to such a context without reliance upon a degree of creativity that renders an extrapolation of*

> *Bayer's teachings non-obvious. The applicant has revised claim 1 to refer to a "motion-transmitting element disposed wholly within the cab" to address this point of distinction. A similar change has been made with respect to independent claims 8 and 18. The applicant respectfully submits that these claims are therefore not anticipated by the Bayer reference and are allowable thereover.*

First, the examiner respectfully submits that applicant's drawings do not show the cab. Consequently, it is unclear as to how applicant defines the boundary of the cab so that the term "disposed wholly within the cab" has a referential datum. In the case at hand, if one defines the boundary of the cab to be the outer surfaces of the vehicle, such as, the frontal area 2 which encloses the engine compartment 3, the doors, the windshield, etc. of the cab as shown in Fig. 1 of Wolpert, Bayer's motion transmitting element 10 is inherently disposed wholly within the boundary in the same manner as applicant's motion transmitting element 12.

Second, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *the applicants address a concern that arises when these various mechanisms are in relatively close proximity to one another . . .*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Similarly, although *Bayer may teach one skilled in the art only that a wire can be utilized to couple a brake pedal arm and actuator arm that reside on different sides of a vehicle cab wall and that are separated by a considerable distance,* however, note that applicant's claims transparently do not call for the pedal arm and actuator arm resided on the same side of the cab, *a fortiori*, applicant's claims are "fully met" by Bayer. It is well settled that anticipation law requires distinction be made between invention described or taught and invention claimed. It does not require that the reference "teach" what subject patent application teaches, it is only necessary that the claim

under attack, as construed by the Court, "*read on*" something disclosed in the reference, *i.e.*, all limitations of the claim are found in reference, or are "*fully met*" by it. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781, 789 (CAFC 1983).

For the reasons set forth above, the rejection based on Bayer is maintained.

Wolpert

In the same vein of arguments, applicant asserts that:

> *Wolpert teaches the use of a rigid transmitting rod (14) to couple a brake pedal arm to an actuator lever. The Examiner argues that such a rod will in fact become shortened when sufficient compressive force is exerted thereon and that such a phenomenon will meet the limitations of the claims. With all due respect, the applicant notes that there are considerable differences between shortening a motion-transmitting element such as a cable or telescoping rod as compared to essentially crushing a rigid member. For example, one can readily return the applicant's motion-transmitting element to a non-shortened state with little effort or force. In contrast, crushing or bending a rigid member will yield a shortened element that can only be returned to its original length by exertion of an equal or greater force as was used to crush or bend it. The applicant has addressed this difference by specifically indicating that the shortening of the motion-transmitting element occurs non-fixedly. That is to say, unlike a fixed resultant shortening that occurs when compressing or bending a rigid rod, the applicant's element is non-fixedly shortened when a compressive force is applied to it such that it can be readily returned to its ordinary length. The applicant therefore respectfully submits that the claims, as amended, are not anticipated by Wolpert and that these claims may be passed to allowance.*

First, the examiner respectfully submits that Wolpert's rod 14 is identical or substantially identical to applicant's rod 12. Wolpert does not need to expressly explain that Wolpert's rod is similar to appellant's rod, thus, they are expected to behave similarly. *In re Merck & Co., Inc.*, 231 USPQ 375 (CAFC 1986) and *In re King*, 231 USPQ 136 (CAFC 1986). When one applies sufficient compressive force on Wolpert's rod 14, the rod 14 is inherently shortened since virtually any rod or bar will be shortened if enough compressive pressure is applied to it. This

fact is well known as evidenced by common engineering text books. See, e.g., page 15-2 through page 15-16 of *Mechanical Design and System Handbook*, author Harold A. Rothbart, McGraw-Hill Book Company attached. It is well settled that 35 USC 102 reference needs not provide such explanation to anticipate when an artisan would know as evidenced by standard text book. *In re Opprecht*, 12 USPQ2d 1235 (CAFC 1989).

Lastly, applicant still does not provide patentable distinguishing structure over Wolpert by adding the limitation "non-fixedly." Indeed, Wolpert's Figs. 1 and 2 plainly show that the rod 14 is moved as seen by the phantom or broken line position of the rod 14 or the pedal 8. Therefore, Wolpert's rod is transparently non-fixed, i.e., *axially displaced* as expressly described in line 28 et seq., column 4. The examiner, therefore, respectfully submits that the claims, as amended, are anticipated by Wolpert and that these claims may not be passed to allowance.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 703-308-3221. The examiner can normally be reached on Tuesday - Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Luong

January 28, 2004

Vinh T. Luong
Primary Examiner

APPENDIX

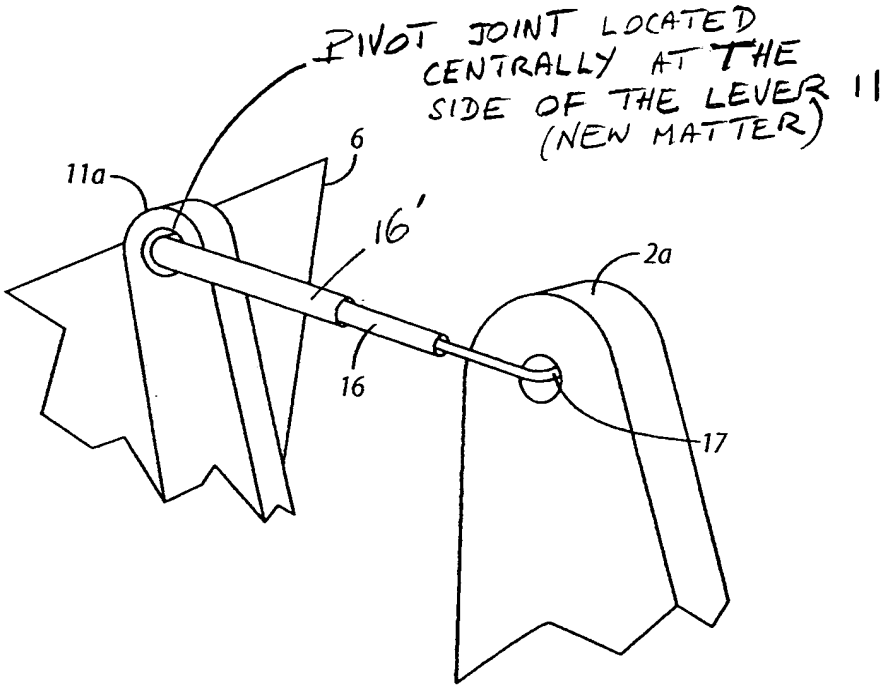

FIG. 3

EXHIBIT - I
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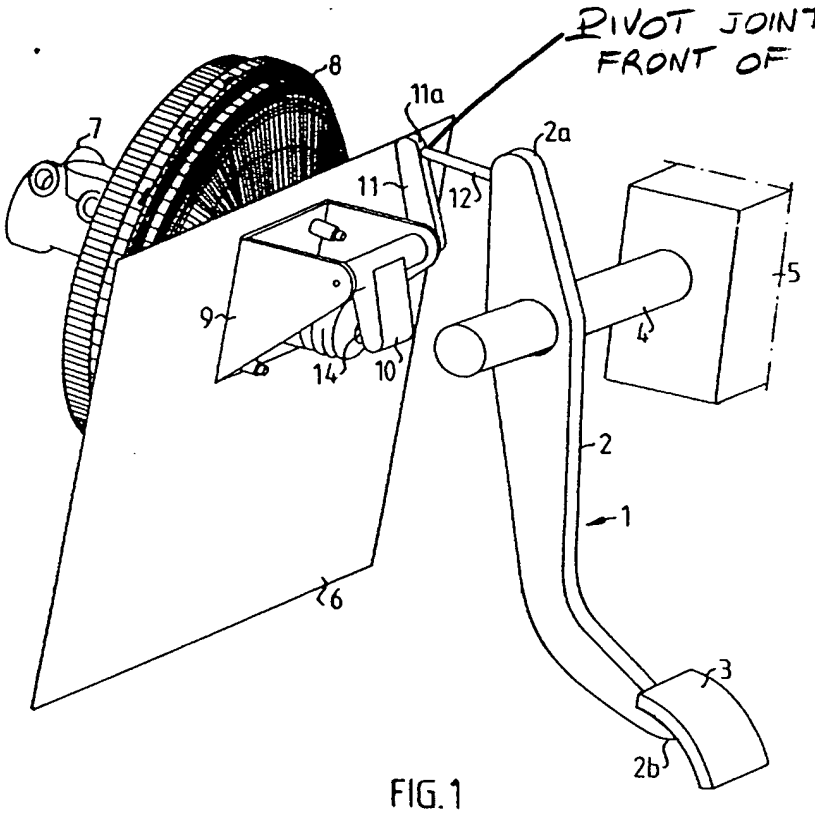

FIG. 1

EXHIBIT _ I
PAGE 2 OF 2

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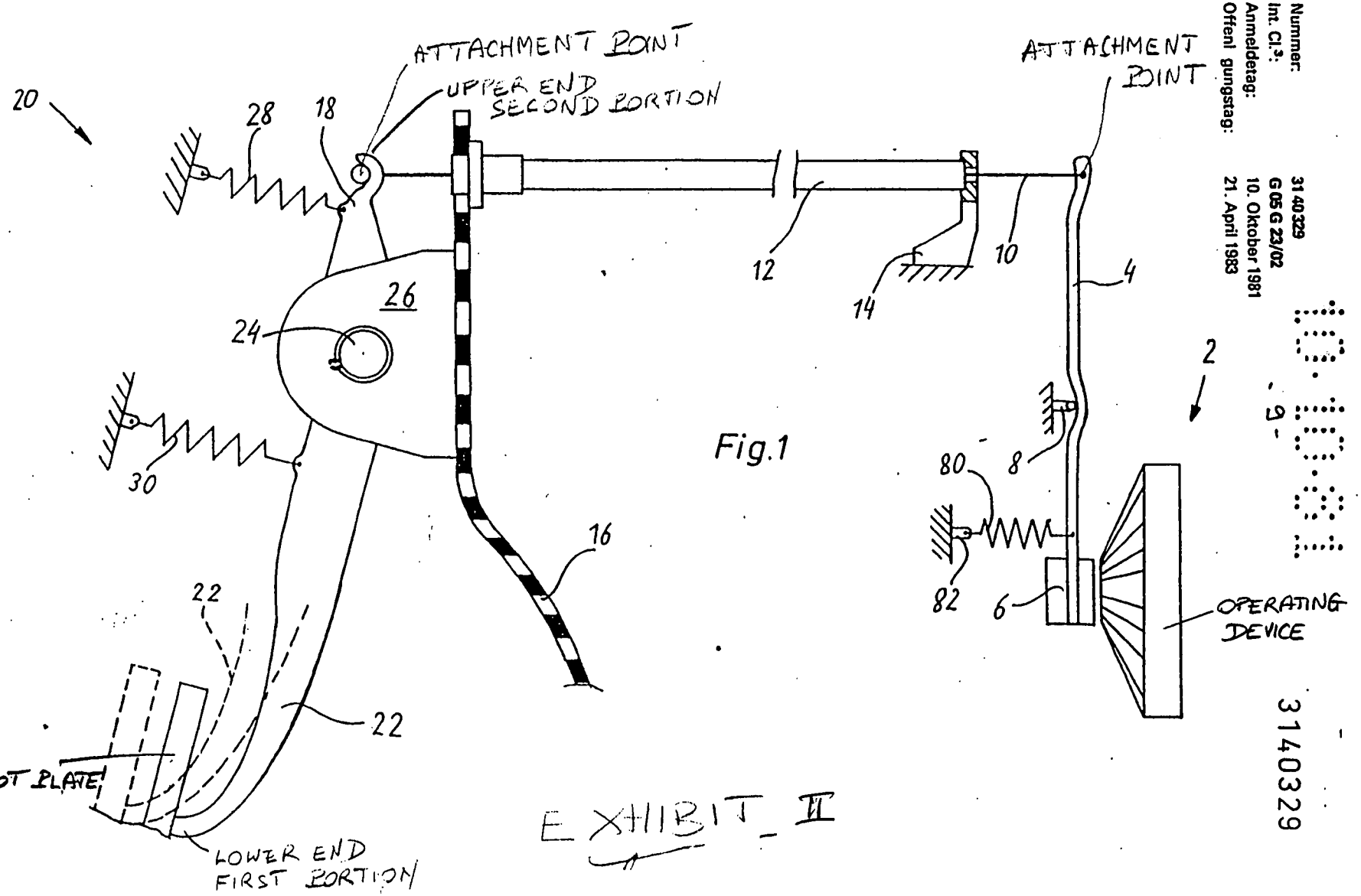

Fig.1

EXHIBIT II

3140329